

Application No. 09/821,694
Amendment dated
Reply to final Office Action of December 14, 2004
EXPEDITED PROCEDURE - GROUP ART UNIT 1634

Atty Dkt No. 0450-0001

REMARKS

THE AMENDMENT TO THE SPECIFICATION

The paragraph at page 24, line 10, to page 9, line 6, of the specification has been amended to correct an obvious typographical error in the specification. Specifically, the shorthand for chemiluminescence (ChL) was misspelt as "CL" at page 24, lines 13 and 15, and thus, has been corrected with this amendment. No new matter is added to the application with these changes.

THE CLAIM AMENDMENTS

Claim 1 has been amended to incorporate the subject matter of canceled claim 116 and to clarify that the at least two oligonucleotide probes having a variable position, wherein on at least one of the at least two oligonucleotide probes, the variable position is occupied by a degenerately base pairing nucleotide analog selected from the group consisting of dP and 8-oxo-dG and on at least one other of the at least two oligonucleotide probes, the variable position is occupied by a degenerately base pairing nucleotide analog selected from the group consisting of dP and 8-oxo-dG or a non-degenerately base pairing nucleotide. Support for the recitation that the variable position may be occupied by dP or 8-oxo-dG on at least one probe and dP, 8-oxo-dG, or a non-degenerate probe on at least one other probe is found in the specification at *inter alia* page 31, line 24, to page 32, line 26.

Claims 7 and 10 have been amended to clarify that the target nucleic acid analyte hybridizes to the array of oligonucleotide probes. Support for the changes to claims 7 and 10 is found in the specification at *inter alia* page 6, lines 12-13; page 18, lines 21-27; page 20, lines 4-12; page 26, line 30, to page 27, line 13 (as well as the discussion of Brenner et al. at pp. 27-29 and the discussion of Fodor and Drmanac at p. 33); page 45, lines 27-32; and Examples 6-8, and 10.

Claims 117 and 118 have been amended to remove superfluous language from claim 117 and to correct the language of the Markush group (i.e., to replace the "or" with an --and--) in claim 118.

No new matter has been added to the application with the amendments to the claims made here.

CLAIM OBJECTION

In the Office Action under reply, the Examiner objected to claim 29 because there were two occurrences of the word "target" in the claim. The second occurrence of the word has been removed with this amendment; accordingly, this objection is now moot.

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INDEFINITENESS REJECTION

Claims 1, 6-15, 18-24, 27-31, 36-39, and 115-118 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite. Specifically, the Examiner references claim 10 as lacking antecedent basis with respect to the hybridization of the target nucleic acid analyte in claim 7.

Claims 7 now reads that the nucleic acid analyte hybridizes to the array and that the target sequence segment is determined by analysis of hybridization data from the array and claim 10 recites that the target sequence segment is detected by a label moiety. Support for the amendment to claims 7 and 10 is set forth above under the subheading "The Claim Amendments."

The changes made to claim 7 and 10 more clearly define the invention recited therein; accordingly, applicant respectfully requests reconsideration and withdrawal of this rejection.

WRITTEN DESCRIPTION REJECTION

Claims 1, 6-15, 18-24, 27-31, 36-39, and 116-118 stand rejected under 35 U.S.C. § 112, first paragraph, as lacking an adequate written description; specifically, the Examiner asserts that there is no support for the two oligonucleotides to be identical except for a single variable position.

Applicant respectfully submits that the discussion of the probes originally identified as SEQ ID NOS 14-16, and 106-109 support the recitation and thus, in this respect traverse the rejection. Notwithstanding the foregoing, applicants have removed the term objected to by the Examiner. With the change to claim 1, applicant respectfully requests reconsideration and withdrawal of this rejection.

ENABLEMENT REJECTION

Claims 1, 6-15, 18-24, 27-31, 36-39, 117, and 118 stand rejected under 35 U.S.C. § 112, first paragraph, as not enabled. With the incorporation of the subject matter of claim 116 into claim 1, this rejection is rendered moot; accordingly, applicant respectfully requests withdrawal of this rejection.

CONCLUSION

Because all of the claim objections and claim rejections set forth by the Examiner have been addressed and fully rebutted with the amendments and arguments set forth in this paper, applicants respectfully request withdrawal of all claim objections and rejections and passage of this application to a patent grant. *See, In re Oetiker, supra.*

With the changes made in this paper, this application is in condition for allowance; accordingly, applicant respectfully requests reconsideration and withdrawal of all claim objections and rejections and

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passage of this application to issue. On this matter, applicant respectfully requests that the Examiner contact the undersigned attorney to resolve any additional issues that may affect the allowance of this application. The Examiner may contact the undersigned attorney at 650-330-4913 or at canaan@reedpatent.com.

Respectfully submitted,

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